



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/926,246	09/05/97	SULLIVAN	SLD-2035-1-2

Q21/0610  
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EXAMINER  
GRAHAM, M

ART UNIT	PAPER NUMBER
3/11	9

DATE MAILED: 06/10/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/926,246

Applicant(s)

Sullivan

Examiner

Mark S. Graham

Group Art Unit

3711

☒ Responsive to communication(s) filed on Apr 22, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3711

The declaration filed on 4/22/99 under 37 CFR 1.131 has been considered but is ineffective to overcome the Proudfit reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Proudfit reference.

The issue at hand is, whether, based on the evidence provided, has a proper showing under 37 CFR 1.131 made so as to antedate the Proudfit reference.

The declaration submitted by applicant was stated to be a showing under 37 CFR 1.131 of "completion" or reduction to practice prior to the effective date of the Proudfit reference. To make such a showing under 37 CFR 1.131 the declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski , 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. Id . at 33; see also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

Art Unit: 3711

In the instant case, the applicant has submitted evidence in the form of two tables styled as "Table 1" and "Table 2." The accompanying statement is that these tables are copies of laboratory notes and other technical material and that these tables correspond to tables 7 and 8 respectively in the instantly filed application. It is further stated that these tables were prepared prior to the effective date of the Proudfit reference. No further explanation is offered.

In the application, table 7 is a listing of various known materials used to formulate the inner cover composition of five golf balls according to the claimed invention and the properties of intermediate golf balls molded with such inner covers. Table 8 details four completed balls of the claimed invention by their inner cover composition as taken from table 7, outer cover composition, and various finished properties. One prior art ball is also detailed in the same manner.

Turning first to table 1 of the declaration, a table corresponding to table 7 is provided, with the exception that it is not indicated that intermediate golf balls are being described or that the recited materials are intended as inner cover compositions. Additionally, the balls are labeled as 61-1 - 61-5 as opposed to A-E in table 7.

Table 2 of the declaration details eight golf balls. Each includes a "core" type which apparently is taken from table 1, although this is not specifically stated, and a "cover" composition. Balls 1-4 and 8 of table 2 correspond to balls 1-5 as regards their physical properties and their cover type. There is, however, no indication of an "inner cover composition". Rather a "core" type is included as part of the table. No explanation of balls 5-7 is provided.

Art Unit: 3711

Analysis of the evidence provided does not indicate that applicant had reduced the invention to practice. An examination of table 7 does not indicate that the materials recited are intended as "inner cover compositions". The materials recited could just as easily be intended as outer cover compositions or one-piece ball compositions and the properties recited, those of finished golf balls. The general accompanying statement in the declaration provides no further details in this regard.

Even if one assumes *arguendo* that table 1 shows intermediate golf balls and their properties with inner cover compositions, there is no evidence that such "inner cover" layers were put together with outer cover layers in Table 2 to show the completed golf ball of the invention. If one assumes that the 61-1 - 61-5 labels of table 1 are the same as those of table 2, (and there is no statement to this effect) the conclusion one would draw is that 61-1 - 61-5 are core compositions for balls 1-4 and 8 of table 2. The designation given to these labels is "core" not "inner cover". In the golf ball art there is obviously a great difference between the two terms.

Because only a general statement regarding the exhibits is provided, and the exhibits themselves do support the applicant's contention in the declaration as explained above, it is the examiner's opinion that the 37 CFR 1.131 declaration is not effective to antedate the Proudfit reference.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 3711

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Proudfit for the reasons set forth in the previous action.

In response to applicant's arguments Proudfit makes clear (Col. 5, line 57 - Col. 6 line 27) that any "hard" IOTEK or SURLYN ionomers may be used in the blends to construct the hard inner layer. This would necessarily include the known IOTEK ionomers recited by the applicant in the instant application. This would necessarily include the properties of these materials including their specific gravities and hardness. (Proudfit specifically discloses the claimed thickness of the core and layers). Obviously the exact hardness of the layers would have been up to the ordinarily skilled artisan depending on distance and feel considerations while also taking into account cut resistance. Proudfit specifically addresses the latter two of these concerns while distance is always a concern. Again absent a showing of unexpected results, the particular parameters of Proudfit's ball, which is formed from the same materials in the same fashion claimed by applicant, would have been obvious to one of ordinary skill in the art. The applicant has pointed to no unexpected results from the particular materials disclosed by Proudfit which he has chosen to employ in the ball of the instant application to fashion a ball such as that disclosed by Proudfit.

Applicant makes one general statement regarding unexpected enhanced durability with no supporting explanation. As this is also one of the thrusts of Proudfit's invention such a general

Art Unit: 3711

statement without supporting evidence and explanation to back it up falls far short of the threshold necessary to overcome Proudfit in this manner.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-8 of copending Application No. 08/920,070. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a golf ball with a hard inner and soft outer layer.

Claims 1-8 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-6 of copending Application No. 08/870,585. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

Art Unit: 3711

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a golf ball with a hard inner and soft outer layer.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). MPEP Section 804.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



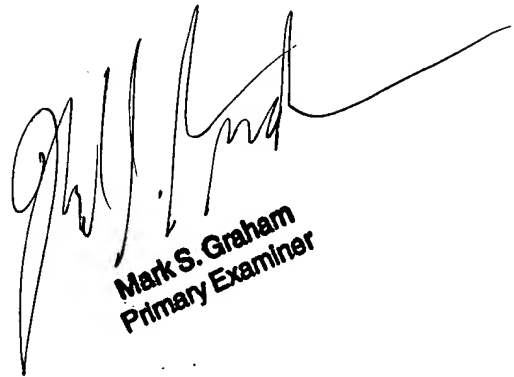
Serial Number: 08/926,246

Page 8

Art Unit: 3711

Any inquiry concerning this communication should be directed to Mark S. Graham at  
telephone number (703) 308-1355.

MSG  
June 28, 1998



Mark S. Graham  
Primary Examiner